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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,732	11/27/2006	Jose Ramon Izquierdo Nunez	HERRA5-72910	1201

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EXAMINER	
KENNEDY, JOSHUA T	
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3679	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/563,732	IZQUIERDO NUNEZ ET AL.	
	Examiner	Art Unit	
	JOSHUA T. KENNEDY	3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 January 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *4 and 5* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *4 and 5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-3 have been cancelled.

Claims 4 and 5 have been examined.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abels et al (WO 02/101250--Examiner uses US Patent 6,935,803 as an English equivalent of this publication).

As to Claim 4. Abels et al disclose a ball joint with thermal protection comprising:

a swivel housing (1) on which one of the suspension components or equivalent is attached having in its interior a housing (2) accommodating a bush (Fig 2) which rests and turns in sliding contact on a ball head (4) of a knuckle stem (5) provided with a dust boot (6) linked by way of its base to the swivel housing (1) and by its neck (14) to an upper section (Fig 2) of the knuckle stem (5), and

a thermal protector (7) integrated in the ball joint protecting the dust boot (6) from high temperatures generated in the surrounding area, characterized in that it incorporates a connecting ring (8) which has a base (8c) and a side face from which the project a series of tabs (8a, and the annular tab between beads 8b and 8c), which is previously linked to the neck of the dust boot (6; Fig 5).

However, Abels et al do not disclose the thermal protector presenting a horizontal upper face with a series of flexible radial plates that define interiorly a circular opening which is fixed to the connecting ring by pressure of the plates on the tabs until they pass over them, with the result that said plates are engaged between the tabs and the base of the connecting ring.

Amrath teaches a ring member (7) presenting a horizontal upper face with a series of flexible radial plates (12) that define interiorly a circular opening (Fig 3) which is fixed by pressure of the plates (12) to fasten two members together in a non-slippable

fashion without having to worry about varying tolerances (Col 1, Lines 21-25). It would have been obvious to one of ordinary skill in the art to modify the horizontal upper face of Abels et al to have flexible radial plates as taught by Amrath to fasten the thermal protector to the bellows in a non-slippable fashion without having to worry about varying tolerances.

Further, Abels et al do not explicitly disclose the thermal protector having angularly distributed tabs around a circumference of the connecting ring. However, having a plurality of tabs distributed about the circumference of a ring and having a single circumferential tab are functional equivalents to one of ordinary skill in the art and it appears as if the instant invention would function equally as well if the series of angularly distributed tabs was actually an infinite amount of angularly distributed tabs forming a single circumferential tab as is shown in Abels et al. Therefore it would have been obvious to one of ordinary skill in the art to modify the single circumferential tab of Abels et al as a person with ordinary skill has good reason to pursue the known options within his or her technical grasp. In turn, because the instant invention as claimed has the properties predicted by the prior art, it would have been obvious to make the single circumferential tab to be a plurality of angularly distributed tabs in order to gain the commonly understood benefits and applications of such an adaptation and/or modification yielding predictable results. The omission of an element (in this case surface area of the tab) and its function in a combination, where the remaining elements perform the same functions as before, involves only routine skill in the art. In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975); In re Karlson, 311 F.2d 581, 136 USPQ 184 (CCPA 1963).

The Courts have made clear that the teaching, suggestion, or motivation test is flexible and an explicit suggestion to combine the prior art is not necessary. The motivation to combine may be implicit and may be found in the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. Id. at 1366, 80 USPQ2d at 1649. "[A]n implicit motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the improvement' is technology- independent and the combination of references results in a

product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient. Because the desire to enhance commercial opportunities by improving a product or process is universal-and even common-sensical- we have held that there exists in these situations a motivation to combine prior art references even absent any hint of suggestion in the references themselves. In such situations, the proper question is whether the ordinary artisan possesses knowledge and skills rendering him capable of combining the prior art references." Id. at 1368, 80 USPQ2d at 1651Examiner notes that the specific method of forming is not germane to the issue of patentability of the device itself. Therefore, the limitation "previously linked to the neck of the dust boot by super injection or pressure and/or gluing" has been given only limited patentable weight and does not serve to structurally distinguish the claims. See MPEP § 2113.

As to Claim 5. Abels et al disclose the thermal protector (7) taking the form of a hood which extends initially in the horizontal upper face and is prolonged inferiorly by way of sloping side edges which terminate in vertical walls defining a spacious cutaway which leaves the dust boot partly exposed in the sector opposite the sector of the ball joint facing a heat source, said vertical walls being separated from the dust boot defining an air chamber between both which produces the thermal insulation of the dust boot (Figs 1c, 2, and 7c).

Response to Arguments

As to the Claims, Applicants argue:

> Abels teaches away from a combination with Amrath. Indeed, the way the projections 9 are described, and the way Abels continually emphasizes that there should be no "axial force" exerted on the bellows 6 (see, for example, column 4, lines 28-38 and column 1, lines 22-31; column 2, lines 25-27), makes it clear that the skilled person would feel reluctant to apply anything similar to the concept disclosed in Amrath to the system disclosed in Abels. (Page 7)

Examiner respectfully disagrees. While the fact that Abels emphasizes that there should be no axial force on the bellows may be true, it is the tabs (12) of Amrath, not the bellows, which are acted upon axially to facilitate engagement (Col 3, Lines 51-53). Since no axial force would be exerted on the bellows of Abels, there is contradiction of concepts or teaching away.

Applicants further argue:

> Moreover, it should be noted that Amrath discloses the connection of a bellows 4 to the ball pin 3. This bellows 4 is said to be of the type that seals off the ball joint connection (see, for example, column 1, lines 11-13). Thus, Amrath deals with the connection of the rubber bellows 4 to the ball pin 3, and not the connection of any thermal protector. Thus, if the skilled person were to apply the teachings of Amrath to the system disclosed by Abels, the skilled person would, at the very most, arrive at something in which the rubber bellows 6 of Abels would be connected to the ball pin 18 by means of a connection system similar to the one described by Amrath. However, there is nothing in Abels or Amrath that would suggest to the skilled person that the protective cap 7 of Abels could or should be connected to any ring in a way different from the way suggested by Abels. This is especially clear in view of the way that Abels focuses on the specific way in which the cap is connected to the rubber bellows by bending the projections 9. (Pages 7-8)

In response, however, the examiner would like to point out that KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. Ex parte Smith, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007). The examiner recommends in the instant case that instead of the applicant arguing the lack of motivation or suggestion in the prior art, the applicant focus rather on the criticality of the claimed features with respect to the prior art and why said features would not be obvious in view of the arguments as presented above. "The question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the *art." KSR Int'l. Co. v. Teleflex Inc.,* 127 S.Ct. 1727, 1742, 82 USPQ2d 1385, 1397 (2007). In making the obviousness determination one "can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR,* 127 S.Ct. at 1741, 82

USPQ2d at 1396. "A person of ordinary skill is also a person of ordinary creativity, not an automaton." *KSR,* 127 S.Ct. at 1742. 82 USPO2d at 1397.

Amrath teaches the concept of providing slots (11) to a solid member to, in turn, form segments which can be bent out of plane to facilitate mounting of such a member onto any cylindrical member. According to KSR, a method of enhancing a particular class of devices (methods, or products) has been made part of the ordinary capabilities of one skilled in the art based upon the teaching of such improvement in other situations. One of ordinary skill in the art would have been capable of applying this known method of enhancement to a "base" device (method, or product) in the prior art and the results would have been predictable to one of ordinary skill in the art. The Supreme Court in KSR noted that if the actual application of the technique would have been beyond the skill of one of ordinary skill in the art, then using the technique would not have been obvious. KSR, 550 U.S., 82 USPQ2d at 1396.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA T. KENNEDY whose telephone number is (571)272-8297. The examiner can normally be reached on M-F: 7am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joshua T. Kennedy/
Examiner, Art Unit 3679

/Daniel P. Stodola/
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